

REMARKS

Claims 39-59 are pending. On an initial note, Applicant wishes to thank the Examiner for highlighting problems associated with use of "at least one of the following" language, and for pointing out the informality in Claim 55. Applicant has made claim adjustments, accordingly. Applicant has amended Claims 39-59 and added Claims 60-68. Support for the amendments to Claims 39, 49, 58, and new Claims 66 and 69 can be found, for example, in Claim 45 and Application paras. [0006] and [0017]-[0023]. Support for the amendments to Claims 40, 46, 48, and 55, can be found, for example, in Application paras. [0002], [0003], [0006], [0012], and [0017] and/or in the respective claims, themselves. Support for the amendments to Claims 41, 42, 44, 45, 47, 50-54, 56, and 59, can be found, for example, in the respective claims themselves. Support for the amendments to Claim 43 can be found, for example, in the claim itself and in Application para. [0015]. Support for the amendments to Claim 57 can be found, for example, in Application para. [0017]. Support for new Claims 60 and 67 can be found, for example, in Claim 46. Support for new Claims 61, 64 (second element), 65 (second element), and 68 can be found in Claims 41 and 44. Support for new Claims 62, 64 (first element), 65 (first element), and 67, can be found, for example, in Claim 40 and in Application paras. [0002], [0003], [0006], [0012], and [0017]. Support for new Claim 63 can be found, for example, in Claim 52. Support for Claims 70-72 can be found in Application paras. [0002], [0016] and [0017]. Applicant submits that these minor amendments and corrections herein are made without prejudice as to patentability, including the doctrine of equivalents, and not to overcome prior art, and that no new matter has been added. The Commissioner is authorized to charge any required fee or provide any refund to the deposit account of Bracewell & Giuliani LLP, Deposit Account No. 500259 (Attorney Docket No. 025656.003).

Claims 39-59 and 60-72 are Novel and Nonobvious

The Examiner has rejected Claims 39-59 as being anticipated under 35 U.S.C. § 102(e) by Gutman et al., US Patent No. 5,221,838, (hereinafter "Gutman"). Applicant respectfully traverses the rejection.

Present Claimed Invention

Applicant recognized the proliferation in the use of various types of credit, debit, identification, and other types of authorization cards, and thus, the need to consolidate the

various cards. The solution was a wireless device or apparatus, also known as a wallet consolidator, capable of warehousing digitized information stored on the cards including account identification and user identification information including card data along with images of the cards, e.g., signatures, portraits, etc., some or all of which would be delivered directly to a point-of-transaction device (point-of-sale or point-of-service) and a portion to the device operator located at the respective point-of-service, if necessary. The problem and eloquent solution was not directed to communicating with the "financial institutions" directly or receiving directly from them, updated balances.

According to the embodiment described in Claim 39, the wallet consolidator includes a controller to control operation of a wallet consolidator, at least one input device connected to the controller of the wallet consolidator to receive a copy of identification information stored on at least one card, a memory device connected to the controller to store the information received by the input device, and an output device connected to the controller and positioned to transmit at least a portion of the information stored in the memory device to a point-of-sale transaction device located at a point-of-sale, which is positioned to process a point-of-sale transaction effectuated pursuant to the at least a portion of the information. In its most generalized configuration, the input device can include, but is not limited to, one or more of the following: a magnetic stripe card reader, a bar code reader, a keypad, a touch screen, a smart card reader, a kiosk, a memory card, a telephony interface, a wireless interface, a wireline communications interface, a wireless communications interface, an infrared (IR) interface, and a radio frequency (RF) interface. The memory device can include, but is not limited to, one or more of the following: semiconductor memory, a smart card (contact, contactless, or hybrid), a memory card (portable flash memory), random access memory (RAM), magnetic memory, or a hard disk magnetic tapes, an optical memory device, and an optical disc. The output device can include, but is not limited to, one or more of the following: a data interface, a telephony interface, a wireless interface, a wireline communications interface, a wireless communications interface, a radio frequency (RF) interface, an infrared (IR) interface, and a display configured for displaying scanable bar codes.

The Gutman System

Gutman, as a whole, teaches an electronic wallet (100) for aiding a user to individually maintain account balance data for various consumer accounts, e.g., bank account, checkbook account, Visa or MasterCard card balances, etc. Particularly, Gutman provides a system, electronic wallet, and method which provides a user direct access to financial institution account balance records from an electronic wallet device and provides to the user of the electronic wallet device an updated account balance maintained at the financial institution. *See Gutman, col. 3, lines 46-58.*

Gutman recognized that, although upon consummating a transaction a person is typically provided a paper receipt requiring a user to manually update the user's log or diary (e.g., checkbook balance), the current account balance information is maintained electronically at the banking facility. *See col. 1, lines 52-59; col. 2, lines 26-31, 37-40, 57-61.* Gutman also recognized that this manual transcription can result in errors. *See col. 2, line 62 to col. 3, line 13.* Gutman's solution was the electronic wallet (100) having a communication means for receiving a wireless message including financial information relating to an account balance for confirming a financial transaction with the financial institution, a storing means for storing such information, and an updating means for updating the balance in the storing means. *See Gutman, col. 3, lines 46-58.*

Gutman identifies six communication methodologies for communicating with the financial institution, which are either directly to a financial institution or through an establishment or secondary financial institution: (1) printing a check that can be presented; (2) displaying information to a representative of the financial institution; (3) presenting a universal financial card representing a preapproved financial card (including financial information stored in the electronic wallet and the card balance); (4) transmitting a message including information relating to the balance to a "communications system terminal equipment (e.g., a paging transceiver 312 (see FIG. 3))"; (5) coupling the electronic wallet to a communication system terminal equipment via the computer interface; and (6) coupling the message to the communication system via telephone lines. *See Gutman, col. 13, line 25 to col. 14, line 16.* Only the fourth, fifth, and sixth methodologies include use of any form of transmission-type device associated with the electronic wallet. Though normally positioned

in close association with the financial institution, the communication system terminal equipment disclosed in Gutman can be positioned at the location of the third party establishment. Such equipment, however, is only configured to *relay* to the financial institution thereto. *See, e.g.*, Gutman, col. 14, lines 17-21 and Gutman Claim 3. Gutman also discloses handshaking with the financial institution using conventional point-of-sales terminal equipment. But such handshake is *only* disclosed as being handled after the establishment receives the universal financial card. *See* Gutman, col. 14, lines 56-59.

Nothing is mentioned of any form of data transmission from the electronic wallet to any actual point-of-sale terminal equipment. Gutman's disclosure of a user physically handing a check, presenting the electronic wallet, or swiping a financial card, is not a disclosure, teaching, or suggestion to one skilled in the art, of an output device of an wallet consolidator, itself, "transmitting" data to a point-of-sale, point-of-service, or other point-of-transaction device. Nor does disclosing transmitting data to communication system terminal (relay) equipment located at the third party establishment for relay to the financial institution, constitute a disclosure, teaching, or suggestion of point-of-sale equipment or otherwise turn that financial institution's communication system relay equipment into point-of-sale equipment, or teach *transmitting* data directly from the electronic wallet (100) to point-of-sale transaction equipment. Further, the only data disclosed by Gutman as transmitted by the electronic wallet (100), itself, is a wireless message transmitted to the financial institution including financial information relating to a balance and maybe address information identifying a destination receiver device corresponding to a central financial institution computer. *See* Gutman, col. 8, lines 43-47 and 57-60.

Thus, Gutman fails to disclose, teach, or suggest (1) embodiments of an output device [of wallet] connected to a memory device or controller positioned to *transmit* at least a portion of the identification information to a point-of-sale or point-of-service transaction device to thereby process a point-of-sale or point-of-service transaction responsive to at least a portion of the information; or (2) embodiments of a method for processing a transaction (using its electronic wallet (100)) including the step of *transmitting* [by the wallet] at least a portion of stored identification information to a point-of-sale or point-of-service transaction device

positioned at a respective point-of-service or a point-of-sale to process a respective point-of-service or point-of-sale transaction responsive to the at least a portion of information.

Claims 39-59 and 60-72 are Not Anticipated by Gutman

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference, whereby the identical invention must be shown *in as complete detail as is contained in the claim*. Applicant respectfully submits that Gutman fails to set forth each and every element featured in Claims 39-59 or each and every element featured in new Claims 60-72.

Specifically, regarding independent Claims 39, 58, and new independent Claims 66 and 69, Gutman, for example, as a minimum, fails to disclose, teach, suggest, or otherwise set forth an output device connected to a controller and positioned to *transmit* at least a portion of information stored in a memory device and received from and previously stored on at least one card, to a point-of-sale or point-of-service transaction device, which is positioned to process a transaction responsive to the at least a portion of the information. The Examiner indicated that the printer (118) is an output device. Although Applicant agrees that it is a type of output device, Applicant respectfully submits that it is not a type of output device capable of "transmitting" information much less one that is capable of "transmitting" information to a point-of-sale, point-of-service, or other type of point-of-transaction device. Nor is the Gutman paging transmitter module (220) used for communicating with the financial institution readily capable of transmitting to the transaction device. Nothing is taught or suggested that these devices are compatible, and as stated previously, the communication system terminal equipment (e.g., a paging transceiver 312 (see FIG. 3)) associated with a third-party, is not a point-of-sale, point-of-service, or other type of point-of-transaction device. *See, e.g.*, Gutman, col. 13, lines 53-57. Correspondingly, Applicant respectfully submits that this element is missing.

Regarding independent Claim 49, Gutman, for example, as a minimum, fails to disclose, teach, suggest, or otherwise set forth the step of transmitting at least a portion of the stored information to a point-of-sale, point-of-service, or other type of point-of-transaction device positioned at a respective point-of-sale or point-of-service to thereby process a respective point-of-sale or point-of-service transaction responsive to said at least a portion of said information. The Examiner cited col. 7, lines 3-40, which describes the electronic wallet (100) receiving

encrypted messages from a financial institution. Again, Applicant respectfully submits that the cited passage and the following passages fail to provide any disclosure, teaching or suggestion of providing any form of communication directly between the electronic wallet (100) and a point-of-sale or point-of-service transaction device, as featured in the claim. Correspondingly, Applicant respectfully submits that this element is missing.

As Gutman fails to disclose, teach, suggest, or set forth each and every element featured in independent Claims 1, 49, 58, 66 (new), and 69 (new), Applicant respectfully submits that such claims have been shown to be novel and define over the cited document. Further, as the independent claims have been shown to be allowable, dependent Claims 2-48, 50-57, 59-65, 67-68, and 70-72 have also been shown to be allowable. Additionally, the dependent claims include independently novel and nonobvious features.

For example, Claims 40, 55, and 64 feature the wallet consolidator, itself, transmitting account identification information to a point-of-sale or point-of-service transaction device positioned to process a transaction effectuated by or responsive to such information. No such teaching is provided by Gutman. As noted above, the electronic wallet (100) communicates either directly with a financial institution or indirectly through communication system terminal equipment (not point-of-sale or service transaction equipment) located at an establishment. Further, Gutman fails to disclose, teach, or suggest that its wireless message between the electronic wallet and the financial institution is anything other than financial information relating to a balance and maybe address information identifying a destination receiver device corresponding to a central financial institution computer. *See* Gutman, col. 8, lines 43-47 and 57-60. Trying to guess what other possible financial information is included, if any, is merely speculative, and therefore, not an enabling teaching of such other information beyond that of account balance and a destination address.

Claims 41, 53, 55, 64, and 72 feature the output device positioned to transmit account identification information to the a point-of-sale or point-of-service transaction device including a *wireless* communication device, with Claims 64 and 72 specifically featuring a wireless radio frequency (RF) communication device. Applicant respectfully submits that Gutman's identification of a point-of-service (POS) device capable of reading a universal (magnetic) financial card is not an enabling disclosure, teaching, or suggestion, to one skilled in the art, of

such a specific point-of-service or sale device configured to, capable of, or otherwise positioned to conduct wireless/wireless RF communication between a wallet consolidator and a point-of-sale or service transaction device, as featured in the claims.

Claims 42, 47, 51, and 56 feature the wallet consolidator including various data entry devices. Claims 42 and 51 feature the input device includes either a touchscreen, a smart card reader, a kiosk, a memory card (flash memory), or radio frequency (RF) interface positioned to receive a [complete] copy of information stored on at least one card. Neither of these input-type devices are disclosed, taught, or suggested by Gutman. Note, although the Gutman electronic wallet (100) includes a receiver (203) and controller (205), the receiver (203) and controller (205) are configured to receive balance information or a confirmation message from the financial institution (col. 15, lines 35-41), and not to a copy of information stored on at least one card, as featured in the claims. Claims 47 and 56 feature the wallet consolidator including a touchscreen or a user input cluster. Neither of these specific input-type devices are disclosed, taught, or suggested by Gutman. *See* Gutman, FIG. 1.

Claim 43 features a controller of the wallet consolidator controlling instructions to be presented to a user to instruct the user on use of the wallet consolidator. Claim 50 includes the step of traversing an action tree, which instructs the user on the use of the wallet consolidator responsive to a selected option. Applicant has reviewed the passages cited by the Examiner, col. 7, lines 6-40, along with the remainder of the document, and found no such disclosure, teaching, or suggestion with respect to providing onboard utilization instructions by its electronic wallet (100).

Claim 44 features a wallet consolidator including a display position to display scanable bar code patterns capable of being scanned by a bar code scanner. Although Gutman discloses being able to scan barcodes using optical wand (116), Gutman fails to disclose, teach, or suggest its display (108) is capable of displaying barcodes *scannable* by a bar code scanner.

Claims 45, 54, and 55, describe some desirable forms of point-of-sale and/or point-of-service transaction device positioned to receive information transmitted from the claimed output device; neither of which are disclosed, taught, or suggested by Gutman. The POS device mentioned by Gutman is one that *only* reads magnetic (universal) card.

Claims 46, 53, 55, 65, and 67 feature the wallet consolidator, itself, transmitting personal identification information, such as that taken from an identification card (drivers license, passport, etc), to a point-of-sale or point-of-service transaction device located at a respective point-of-sale or point-of-service transaction to process a transaction effectuated by or otherwise responsive to such information. No such disclosure, teaching or suggestion is provided by Gutman. As noted above, the electronic wallet (100) is disclosed as being configured to communicate either directly with a financial institution or indirectly through communication system terminal equipment (not point-of-sale or service transaction equipment) located at an establishment. Further, Gutman fails to disclose that its wireless messages between the electronic wallet and the financial institution is anything other than financial information relating to a balance and maybe address information identifying a destination device corresponding to a central financial institution computer. *See* Gutman, col. 8, lines 43-47 and 57-60.

Claims 48, 57, 59, and 70 involve unique features, directed at personalized financial cards, not disclosed in Gutman. Claim 48 features a smart card writer positioned to write information to a personalized smart card. Claim 57 features a writer positioned to write information with respect to multiple cards to a personalized transaction card. Claim 59 features a wallet consolidator having an input positioned to receive information from a smart card. Claim 70 specifically features the at least one card includes a driver's license card. Applicant respectfully submits that although Gutman discloses a financial card reader (122) for reading conventional financial cards (e.g., a MasterCard or a Visa card) and a financial card writer (128) configured to write to a universal financial card (130) (col. 5, line 44 to col. 6, line 9), Gutman fails to disclose, teach, or suggest a reader or writer capable of reading from or writing to a smart card (Claims 48 and 59), nor that its universal card can store data regarding multiple other cards simultaneously (Claim 57), nor that it can read personal identification cards (Claims 70). The Gutman universal financial card (130) is not a smart card as known to those skilled in the art, and is not disclosed, taught, or suggested as being capable of storing more than one card's data at one time. Nor would one skilled in the art be motivated to combine any of the other references of record to add such a device or devices to the Gutman electronic wallet in an attempt to build either of these claimed embodiments of Applicant's invention.

Claim 50 features the step of providing a user an option to...access information including one or more of the following: an electronic coupon, personal identification information, or a medical record; this in addition to the above identified step of traversing an action tree. In contrast, Gutman discloses financial information relating to an account balance. *See col. 3, lines 52-58.* Thus, Gutman fails to disclose, teach, or suggest either of the features of this claim.

Claims 54 and 71 feature that the received information includes a digitized image of at least one of the financial and/or identification cards, etc. Applicant respectfully submits that although Gutman discloses a liquid crystal display (108) to display balance information, Gutman fails to disclose, teach, or suggest the ability to receive, scan, or display a *digitized image* of anything. This is an important feature, as many cards, driver's licenses, passports, credit or debit cards, etc. either include a photograph or portrait or some other image, which may be required by the point-of-sale or service transaction operator to effectuate such transaction.

Claim 55 features, in addition to the previously described features, a controller comprising either a personal digital assistant or cellular telephone. Applicant respectfully submits that although Gutman does include a controller (205), Gutman simply fails to disclose, teach, or suggest that its electronic wallet (100) can be either controlled or provided in such form. This is not only an important novel and nonobvious feature, but can be an important commercial feature as the implementation of the wallet consolidator in such PDA or cellular telephone can enhance the functionality, usefulness, portability, and consumer acceptance of such device beyond that imagined by others.

Claims 61, 65 and 68 feature the output device including a wireless communication device positioned to transmit personal identification information to the a point-of-sale or service transaction device, and Claims 65 and 68 specifically include a wireless radio frequency (RF) communication device. Applicant respectfully submits that Gutman's identification of a point-of-service (POS) device capable of reading a universal financial card is not an enabling disclosure, teaching, or suggestion of a specific point-of-service or sale device configured to, capable of, or otherwise positioned to provide wireless/wireless RF communication between itself and a wallet consolidator, as featured in the claims.

Claim 62 features a writer positioned to write personal identification information to a personalized transaction card. Although Gutman discloses a financial card writer (128)

configured to write to a universal financial card (130) (col. 5, line 66 to col. 6, line 9), Gutman fails to disclose, teach, or suggest that it contains or can obtain personal identification information from a card, or that it is capable of writing personal identification information to its universal financial card. The universal card, instead, is identified as a universal credit card apparently capable of holding only a single credit cards data at any given moment in its magnetic strip.

Claim 63 features that the memory device feature of Claim 48 comprises one or more of the following *mobile* types of memory: a smart card, a memory (flash) card, a magnetic tape, an optical memory device, or an optical disc. Applicant respectfully submits that although Gutman discloses non-volatile memory (207), such memory is not a functional equivalent. One skilled in the art would expect the memory utilized by Gutman to be conventional *fixed* semiconductor memory such as they utilized in a calculator, rather than either of the forms of *mobile* memory featured in this claim. Thus, Gutman fails to disclose, teach, or suggest such claimed features.

Correspondingly, Applicant has shown Claims 39-72 to be both novel and nonobvious over the cited document. Applicant respectfully submits that the Application is in condition for allowance.

In commenting upon the cited document and in order to facilitate a better understanding of the differences that are expressed in the claims, certain details of distinction between the document and the claimed embodiments of the present invention have been mentioned, even though such differences do not appear in all of the claims. It is not intended by mentioning any such unclaimed distinctions to create any implied limitations in the claims. Not all of the distinctions between the document and claimed embodiments of Applicant's present invention have been made by Applicant. For the foregoing reasons, Applicant reserves the right to submit additional evidence showing the distinctions between claimed embodiments of Applicant's invention to be nonobvious in view of the cited document(s).

The foregoing remarks, made without prejudice as to patentability, including the doctrine of equivalents, are intended to assist the Examiner in re-examining the application and in the course of explanation may employ shortened or more specific or variant descriptions of some of the claim language. Such descriptions are not intended to limit the scope of the claims; the actual claim language should be considered in each case. Furthermore, the remarks are not to be

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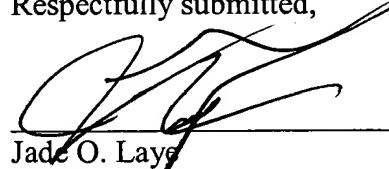
considered to be exhaustive of the facets of the claimed embodiments of the invention that render it patentable, being only examples of certain advantageous features and differences that Applicant's attorney chooses to mention at this time.

CONCLUSION

In view of the remarks set forth herein, Applicant respectfully submits that the application is in condition for allowance. Accordingly, issuance of a Notice of Allowance in due course is respectfully requested.

Respectfully submitted,

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